

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) E0019/258247																	
I hereby certify that this correspondence is being filed VIA EFS WEB (ONLINE) [37 CFR 1.8] on December 26, 2007 Signature <u> / Gina Hamrick / </u> Typed or printed Name <u> Gina Hamrick </u>		Application Number 10/021,468	Filed October 29, 2001																
		First Named Inventor Patrick Aliffi																	
		Art Unit 3621	Examiner Calvin L. Hewitt, II																
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <table border="0"><tr><td>I am the</td><td><u>/Jason D. Gardner 58180/</u></td></tr><tr><td><input type="checkbox"/> applicant/inventor.</td><td>Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest.</td><td><u>Jason D. Gardner</u></td></tr><tr><td>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record.</td><td><u>404-745-2520</u></td></tr><tr><td>Registration number <u>58,180</u></td><td>Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</td><td><u>December 26, 2007</u></td></tr><tr><td>Registration number _____</td><td>Date</td></tr></table>				I am the	<u>/Jason D. Gardner 58180/</u>	<input type="checkbox"/> applicant/inventor.	Signature	<input type="checkbox"/> assignee of record of the entire interest.	<u>Jason D. Gardner</u>	See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record.	<u>404-745-2520</u>	Registration number <u>58,180</u>	Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.	<u>December 26, 2007</u>	Registration number _____	Date
I am the	<u>/Jason D. Gardner 58180/</u>																		
<input type="checkbox"/> applicant/inventor.	Signature																		
<input type="checkbox"/> assignee of record of the entire interest.	<u>Jason D. Gardner</u>																		
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Typed or printed name																		
<input checked="" type="checkbox"/> attorney or agent of record.	<u>404-745-2520</u>																		
Registration number <u>58,180</u>	Telephone number																		
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.	<u>December 26, 2007</u>																		
Registration number _____	Date																		
<input type="checkbox"/> *Total of _____ forms are submitted.																			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Patrick Aliffi et al.

CONFIRMATION NO.: 2136

SERIAL NO.: 10/021,468

GROUP ART UNIT: 3621

FILED: October 29, 2001

EXAMINER: Hewitt II, Calvin L.

FOR: **SYSTEM AND METHOD FOR
FACILITATING RECIPROCATIVE
SMALL BUSINESS FINANCIAL
INFORMATION EXCHANGES**

**CERTIFICATE OF TRANSMISSION UNDER
37 CFR 1.8**

I hereby certify that this correspondence, together with any correspondence referred to as enclosed or attached, is being electronically filed with United States Patent Office via EFS Web on December 26, 2007.

/Gina Hamrick/

Gina Hamrick

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Attorney Docket No.: E0019/258247
Date: December 26, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Responsive to the Final Office Action dated September 24, 2007, ("Final Action"), and the Advisory Action dated November 26, 2007, ("Advisory Action"), Assignee requests a pre-appeal brief review in the application identified above. A concise statement setting forth the reasons for the request is set forth below.

REASONS FOR THE REQUEST

First, the Advisory Action refused to enter claim amendments proposed in a response to the Final Action filed November 1, 2007 ("Response") although the Final Action expressly set forth suggested subject matter of the amendments. Furthermore, the amendments overcome claim rejections under 35 U.S.C. § 112, second paragraph, newly raised in the Final Action, and therefore place the claims in condition for allowance or at least in better form for consideration on appeal. Accordingly, Assignee asserts that, based on the requirements of 37 C.F.R. § 1.116(b), the Advisory Action improperly refused entry of the amendments. Assignee requests

review of the improper refusal to enter the amendments in view of the Remarks set forth below and the recommendations in the Final Action.

Second, the Final Action and the Advisory Action failed to establish a *prima facie* basis for rejecting claims 1-11, 16-21, 23, 24, and 26-31 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,405,175 to Ng (“Ng”) in view of U.S. Patent No. 7,092,821 to Mizrahi *et al.* (“Mizrahi”) and U.S. Patent No. 7,181,518 to Matsumoto *et al.* (“Matsumoto”). The Final Action and Advisory Action also failed to establish a *prima facie* basis for rejecting claims 12-15, and 22 under 35 U.S.C. § 103(a) as obvious over Ng, Mizrahi, Matsumoto, and U.S. Patent No. 5,710,884 to Dedrick. These are the only remaining prior art-based rejections in this case. Claims 103 and 104 are not rejected based on prior art. Applicant respectfully requests the review of the erroneous rejection in view of the Remarks set forth below and in view of the previous arguments by Assignee.

REMARKS

I. Section 112 Rejections

The Advisory Action refuses entry of all claim amendments submitted by Assignee on pp. 2-19 of the Response. Assignee submitted the amendments based on the identification of a supposed omitted essential step from the claims of “previously contributing a data element” set forth on p. 3 of the Final Action. Moreover, the amendments overcame the newly set forth rejections of claims 1-31, 103 and 104 under 35 U.S.C. § 112, second paragraph on pp. 2-3 of the Final Action. Assignee asserts that the refusal to enter the amendments is improper at least because the amendments complied with requirements of form expressly set forth in the Final

Action, which may be made as a matter right under the provisions of 37 C.F.R. § 1.116(b)(1) and MPEP 714.12.

P. 3 of the Final Action states that the claims omitted an essential step of “previously contributing a data element” to support the claim recitation of “contributed data element” in independent claims 1 and 27. In response to this statement, Assignee amended claims 1 and 27 to recite, “contributed data elements contributed by the contributing member.” (Underlining indicating added language). Accordingly, the limitation “contributed by the contributing member” was introduced in claims 1 and 27 to comply with the requirement of form expressly set forth in the Final Action, and presented the rejected claims in better form for consideration on appeal. Assignee also made other amendments to claim 1 and 27, as reflected on pages 2-3 and 8-9 of the Response, to place the claims in better form for consideration on appeal. Therefore, the amendments may be made as a matter of right under the provisions of 37 C.F.R. § 1.116(b)(1) and (2) and MPEP 714.12.

P. 2 of the Advisory Action erroneously refused to enter the amendments asserting that they would require further consideration or search. The Advisory Action stated that the amendments appear to be non-functional data as the input content is not used to generate a score or determine access. However, it fails to identify any specific problems in the amendments, as the amendments did not add language related to “input content.” Moreover, the amendments did not change the relationship of “input content” to determining a score and access to the exchange repository. Claim 1 is directed to input content comprising contributed data elements, where the type and number of which are the subject of statistics in a statistics file that is scored and used to determine access to the exchange repository. Assignee requests review of the improper refusal

to enter the amendments. Entry of the amendments and withdrawal of the rejection is kindly requested. Moreover, if these amendments are entered, as is proper, claims 103 and 104, which were not rejected based on prior art, are allowable.

II. Section 103 Rejections

Pp. 3-6 of the Final Action, imposed a new rejection on claims 1-11, 16-21, 23, 24, and 26-31 under 35 U.S.C. § 103(a) as *prima facie* obvious over Ng in view of Mizrahi and Matsumoto. On pp. 21-27 of the Response, Assignee traversed the rejection and fully set forth traversal arguments. The Advisory Action failed to respond to Assignee's arguments. In summary, Assignee argued that the Final Action failed to establish a *prima facie* case of obvious because the rejection did not meet the basic criteria set forth in MPEP 2143 and, even so, one skilled in the art has no reason to combine the disclosures in Ng, Mizrahi, and Matsumoto.

Specifically, Assignee argued that the Final Action failed to articulate a reason why one skilled in the art would combine the disclosure of Ng and Mizrahi with Matsumoto. P. 6 of the Final Action stated, "it would have been obvious to one of ordinary skill to combine the teachings of Ng and Mizrahi et al. in order to limit the effects of or prevent fraudulent product reviews [citations omitted]." A finding of obvious requires a determination of whether there was an apparent reason to combine elements in references and to articulate that reason to make the analysis explicit. *See Ex parte Catan*, 2007 WL 1934867 at *5, 83 U.S.P.Q.2d 1569 (Bd.Pat.App. & Interf.)(citing *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. ___, 82 U.S.P.Q.2d 1385, 1396 (2007)). Because the Final Action failed to articulate an apparent reason to combine elements in Matsumoto with Ng and/or Mizrahi, it failed to establish *prima facie* obviousness of

claims 1-11, 16-21, 23, 24, and 26-31. Withdrawal of the rejection and allowance of claims 1-11, 16-21, 23, 24, and 26-31 is respectfully requested.

Furthermore, as detailed on pp. 22-27 of the Response, no reason exists for one skilled in the art to combine the disclosures of Ng and Mizrahi or Ng, Mizrahi, and Matsumto. One skilled in the art has no apparent reason to combine the disclosures of Ng and Mizrahi since (A) a combination would destroy the reward incentive function in Ng; (B) Ng teaches away from the claimed invention because it outputs rewards which are not data, and which are independent of the type and number of data elements contributed by the user; and (C) Mizrahi teaches away from the claimed invention because it controls input of information instead of access to receive information. One skilled in the art also has no apparent reason to combine the disclosures of Ng, Mizrahi, and Matsumoto since, as detailed on pp. 26-27 of the Response, a combination of Matsumoto with Ng would destroy the reward incentive function in Ng. For at least these reasons, the Final Action failed to establish *prima facie* obviousness and the rejection of the claims under 35 U.S.C. § 103(a) as *prima facie* obvious should be withdrawn.

CONCLUSION

For the reasons set forth above, Assignee respectfully requests allowance of the pending claims.

Respectfully submitted,
/Jason D. Gardner 58180/
Jason D. Gardner
Reg. No. 58,180

Date: December 26, 2007
KILPATRICK STOCKTON LLP
Suite 2800, 1100 Peachtree Street
Atlanta, Georgia 30309-4530
(404) 745-2520